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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,578	08/24/1998	TAKESHI KAMEDA	0033-0599P	4264

2292 7590 11/26/2003

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EXAMINER

KUMAR, PANKAJ

ART UNIT PAPER NUMBER

2631

DATE MAILED: 11/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/138,578

Applicant(s)

KAMEDA ET AL.

Examiner

Pankaj Kumar

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: amendments to claim 1.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-9.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is in response to amendment after final filed 11/17/2003 in which claims 1-9 are pending. The applicant's amendments will not be entered because they are not deemed to place the case in condition for allowance. The proposed amendments raised issues that will require further search and/or examination. The request entry is denied. (see Advisory attachment)

### **EXAMINER'S REMARKS**

Applicant says that in their after final response, they have made amendments solely to address 35USC112 issues and do not affect the scope of the claim and implies that it would not require further consideration. This is not persuasive since even if applicant intended to only make amendments to address 35USC112 issues, the amendments have caused the meaning of the claims to be altered (and actually are still indefinite – see last few paragraphs of this action) and thus the amendments require further search and/or examination and accordingly will not be entered.

Applicant argues that the prior action should not have been made final since there was a new reference cited. This is not persuasive since applicant's amendments necessitated new grounds of rejection (see the following history of the applicant for further explanation).

The history of the application is the following:

paper 5 was a non-final rejection based on 35USC112, 35USC102(b)

applicant filed an amendment in paper 6 which applicant purports to solely address the 35USC112 issues and do not affect the scope of the claim and the applicant argued with the 35USC102(b)

paper 7 was a final rejection based on the fact that applicant's amendment made the claims unclear and hence the rejection was now only based on 35USC112.

paper 8 was an interview summary in which it was determined that the next action would override the prior action since applicant argued that even if claim(s) are not clear, the examiner is supposed to make his best guess otherwise, since there were no other rejection other than 35USC112, applicant argued that the case was allowable if that rejection was overcome. It was not the intention of the office to automatically allow the case after the 35USC112 rejection is overcome. It was the intention of the office to understand what the applicant is trying to claim after the 35USC112 rejection is overcome and then determine whether this case should be allowed or not. Hence a possible new search and examination would be required after the 35USC112 rejection is overcome.

In any event, the applicant argued that the examiner was supposed to make his best guess as to what the applicant meant and accordingly make additional rejections besides for 35USC112, if needed, based on his best guess. Accordingly, in order to satisfy the applicant, the examiner made another final rejection action in paper 9 in order to override the prior final rejection action. This paper 9 final rejection action overrides the paper 7 final rejection action. Paper 9 incorporates the examiner's best guess as to what the applicant meant to claim. Paper 9 is also a new grounds of rejection as necessitated by applicant's amendments in paper 6 (after the non-final rejection in paper 5) since the meaning of the claim has changed as determined by the

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office (even though applicant believes that the scope of the claim has not changed). Since applicant's amendments in paper 6 necessitated new grounds of rejection, the citing of new reference(s) is proper in final rejection paper 9 just like it would have been proper in final rejection paper 7.

As per the Szczebak reference, applicant argues that it is not inherent to adjust timing when data is adjusted from a synchronous system to an asynchronous system. This is not persuasive since what is claimed is adjusting timing of the input data – where the input data is from the synchronous and the input data is transmitted in the asynchronous system (“claim 1: ... adjusting the timing of input of the data output from said synchronous system and the data transmitted in the asynchronous system ...”). Applicants do not claim to adjust timing when data is adjusted. Applicant's arguments relate to adjusting time, which is different than applicant's claims and office's examination based on adjusting timing of the input data.

Also claim 1 still does not make sense at least with the following: “... adjusting the timing of input of one of the data output from said synchronous system and the data transmitted in the asynchronous system from said preceding stage to said data holding unit ...”. Is the applicant saying that only one data is output from the synchronous system and then their system stops working? This is most likely not the case and so this claim is still indefinite at least for this reason. If the input data is from the synchronous system and the input data is transmitted in the asynchronous system, then what is going from the preceding stage to the data holding unit? If

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the input data is either the data output from said synchronous system or the data transmitted in the asynchronous system, then what is receiving the input data?

Also, "the data received and held" lacks antecedent basis since only "data transmitted" and "data output" and "data holding unit receiving and holding" have been stated.

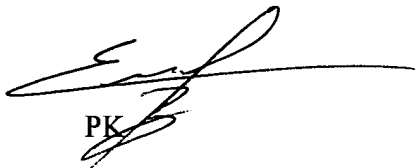
Also "data output from said synchronous system" is indefinite since it is not clear whether this is referring to the earlier statement in the claim where it says "data output from an external synchronous system". Maybe it should say 'the data output from said synchronous system'

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Mon, Tues, Wed and Thurs after 8AM to after 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad H. Ghayour can be reached on (703) 306-3034. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



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